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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,609	01/17/2001	Donald W. Malackowski	29997/035A	7844

7590

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EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/764,609

Applicant(s)

MALACKOWSKI ET AL.

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004 and 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 80-106 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 80-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Specification***

1. The abstract of the disclosure is objected to because it does not adequately summarize the invention. Correction is required. See MPEP § 608.01(b).

***Claim Objections***

2. Claim 3 is objected to because of the following informalities: claim 3, line 2, “identification” should be –identification information—(note claim 84). Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-34 and 80-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chader et al. (U.S. Pat. 5,617,857) for the reasons set forth in numbered paragraph 3 of the previous Office Action paper number 24.

As to the new functional limitations of claims 2, 24 and 30, the smart instrument of Chader et al., as previously obviously modified to communicate bidirectionally with the surgery system in a wireless manner, will inherently have a limiting range in which the wireless connection is established and maintained (this is inherently in any wireless communication device). Thus, no wireless communication will result unless the instrument is in this range, or “field of detection”. As to the transmission of information “in response to a received signal from

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the surgery system”, Chader et al. discloses the transmission of a signal from the surgery system to the instrument to prompt the instrument to transmit stored information back to the surgery system (col.6, lines 49-55). Inherently, this would be done wirelessly when modified to include a bidirectional communication link as previously described. Therefore, Chader et al. is certainly capable of functioning in the manner as now claimed in claims 2, 24 and 30.

As to amended claims 3, 84 and 91, the instrument characteristics stored in memory and transferred to the surgery system “identifies” the instrument type (col.6, lines 55-60) for proper operation of the surgery system. Thus the transmitted information is identification information.

Claims 4, 7, 10-12, 85, 94 and 97-99 are rejected for the reasons set forth in numbered paragraph 5 of the previous Office Action, paper number 24.

5. Claims 1-34 and 80-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chader et al. in view of Acker et al. (U.S. Pat. 6,453,190) for the reasons set forth in numbered paragraph 4 of the previous Office Action, paper number 24.

As to the new functional limitations of claims 2, 24 and 30, the smart instrument of Chader et al., as previously obviously modified by the teaching of Acker et al. to communicate bidirectionally with the surgery system in a wireless manner, will inherently have a limiting range in which the wireless connection is established and maintained (this is inherently in any wireless communication device). Thus, no wireless communication will result unless the instrument is in this range, or “field of detection”. As to the transmission of information “in response to a received signal from the surgery system”, Chader et al. discloses the transmission of a signal from the surgery system to the instrument to prompt the instrument to transmit stored

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information back to the surgery system (col.6, lines 49-55). Inherently, this would be done wirelessly when modified to include a bidirectional communication link as previously described. Therefore, Chader et al. is certainly capable of functioning in the manner as now claimed in claims 2, 24 and 30.

As to amended claims 3, 84 and 91, the instrument characteristics stored in memory and transferred to the surgery system “identifies” the instrument type (col.6, lines 55-60) for proper operation of the surgery system. Thus the transmitted information is identification information.

Claims 4, 7, 10-12, 85, 94 and 97-99 are rejected for the reasons set forth in numbered paragraph 6 of the previous Office Action, paper number 24.

### ***Response to Arguments***

6. Applicant's arguments filed April 12, 2004 have been fully considered but they are not persuasive.

As pointed out in the Advisory Action, the Declarations under 37 CFR 1.132 filed April 12, 2004 and April 22, 2004 are insufficient to overcome the rejection of claims 1-34 and 80-106 based upon Chader et al. as set forth in the last Office action because: they include statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. The purported advantages of such subject matter is nothing more than what the ordinarily skilled artisan would expect from a wireless system, as pointed out in the Examiner's rejections.

Regarding the “self-identifying” feature added to claims 2, 24 and 30, Applicant acknowledges that the instrument is identified in the Chader et al. system (first line of page 13)

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but is done so with a *physical connection*. There is no physical connection when obviously modified to use wireless communication. It is evident that Applicant is again addressing the Chader et al. reference as if it were being applied as an anticipatory reference, without taking into consideration the obviousness set forth in the Examiner's rejections. Therefore, this argument is considered moot. However, the feature of claims 2, 24, and 30 has been addressed in the rejections appearing above.

Regarding the Acker et al. reference, as previously pointed out, the fact that Acker et al. teaches a "magnetic system" is irrelevant to the particular teaching the Examiner is relying on in this reference. Acker et al. demonstrates the level of ordinary skill with respect to making the modification proposed by the Examiner (wireless instead of a hard-wired connection) and, more importantly, offers documented motivation for making such modification.

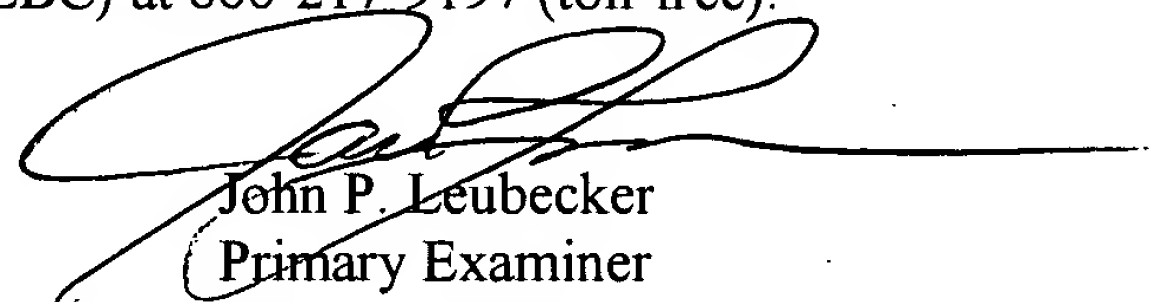
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl